

REMARKS

Claim Status

Claims 1-2, 4-5, and 7-18 are pending in the present application. No additional claims fee is believed to be due.

Claim 6 has been canceled without prejudice.

Claim 1 has been amended to include the feature of an elastic waist band configured to act as an extensibility controlling means. Support for this amendment is found at page 12, lines 13-15 of the specification. Claim 1 has also been amended to recite the feature of a chassis layer including an inner sheet and an outer sheet joined to one another to form a laminate wherein when the waist panel is subject to tension, discontinuities provide openings that extend through the laminate of the chassis layer thereby providing the chassis layer with extensibility in the transverse direction. Support for this amendment is found at page 5, lines 29-35; and figure 3 of the specification.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of the changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §112, first paragraph

Claims 1, 2, 4, 5, and 7-18 have been rejected under 35 U.S.C. §112, first paragraph, because the specification, while being enabling for an extensibility controlling means, allegedly does not reasonably provide enablement for a specific structure or material that inhibits the chassis layer from extending beyond 20% at a tension force of 125 g/25 mm. Applicants respectfully traverse the rejection.

Before any analysis of enablement can occur, it is necessary for the examiner to construe the claims. (MPEP §2164.04). Additionally, "the standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured

the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied.” (*In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)). The court in *In re Wands* laid out a list of factors to consider when determining whether the experimentation required to practice an invention is undue or unreasonable. (*Id.*).

Applicants are unable to find any claim construction in the Office Action or any analysis involving the *Wands* factors. Therefore, Applicants respectfully submit that the Office has not properly shown that Applicants’ specification is not enabling.

Notwithstanding the foregoing, claim 1 has been amended to recite, among other things, an elastic waist band configured as an extensibility controlling means, wherein the elastic waist band inhibits the chassis layer from extending beyond 20% at a tension force of 125 grams/25mm. As pointed out by the Office Action, Nakahata refers to several U.S. patents which disclose a variety of elastic waist features configurations. (The Office Action, page 4; and Nakahata, col. 8, lines 11-20). From these disclosures (i.e., knowledge generally available) and the teachings of the present application, Applicants submit that one of ordinary skill in the art could easily provide an elastic waist band that inhibits the chassis layer from extending beyond 20% at a tension force of 125 grams/25mm, for example, by purchasing such elastic material from one or more of the disclosed material suppliers and configuring it as an elastic waist band feature. (See, e.g., U.S. Pat. No. 4,515,595, col. 7, line 31 – col. 9, line 68; and U.S. Pat. No. 5,221,274 at col. 12, line 24 – col. 13, line 15; and U.S. Pat. No. 5,221,274, col. 14, line 52 – col. 15, line 15).

In view of the foregoing remarks, Applicants submit that the specification provides sufficient disclosure to enable one of ordinary skill in the art to make the extensibility controlling means recited in claim 1 of the present application. Accordingly, Applicants respectfully request that the rejection of claims 1, 2, 4, 5, and 7-18 under 35 U.S.C. §112, first paragraph be withdrawn.

Rejection Under 35 USC §103(a) Over Nakahata in view of Malowaniec

Claims 1, 2, 4, 5, and 7-18 have been rejected under 35 USC §103(a) as being unpatentable over U.S. Pat. No. 5,873,868 to Nakahata, et al. (hereinafter "Nakahata") in view of U.S. Pat. No. 6,049,915 to Malowaniec (hereinafter "Malowaniec"). Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Office must show that all of the claim elements are taught or suggested in the prior art. (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 68 U.S.P.Q.2D 1940 (Fed. Cir. 2003)).

As best understood by Applicants, Nakahata is directed to a disposable diaper comprising an elastically extensible topsheet that has a plurality of slits extending through the topsheet. (Nakahata, Abstract). It is further Applicants' understanding that Malowaniec is directed to a disposable item of clothing that comprises an essentially inelastic layer of a soft, flexible and plastic material; and a layer of elastic material extending over at least a partial region of the inelastic layer. (Malowaniec, Abstract). The inelastic layer includes a plurality of incisions therethrough. (*Id.*).

First, Applicants are unable to find any teaching or suggestion in the combination of Nakahata and Malowaniec of an inner sheet and an outer sheet joined to one another to form a laminate, a plurality of spaced discontinuities regularly disposed in at least a portion of the first or second waist panel such that when the waist panel is subject to tension the discontinuities provide openings that extend through the laminate of the chassis layer thereby providing the chassis layer with extensibility in the transverse direction, as recited in claim 1 of the present application. Therefore, Applicants submit that the combination of Nakahata and Malowaniec does not teach or suggest each and every element recited in claim 1 or any claim depending therefrom.

Second, it is Applicants' position that there is no motivation for one of ordinary skill in the art to modify the article of Nakahata to configure an elastic waist band as an extensibility controlling means, wherein the elastic waist band inhibits the chassis layer

from extending beyond 20% at a tension force of 125 grams/25mm, as recited in claim 1 of the present application.

The Office Action asserts that the article of Nakahata as modified by Malowaniec discloses an extensibility controlling means in the form of elastic waist feature. (The Office Action, page 6). The Office Action states that “Nakahata discloses a material for the elastic waist feature that is identical to a material disclosed by applicant for the claimed extensibility control means, Nakahata certainly fairly suggest an extensibility controlling means.” (*Id.*).

Applicants respectfully remind the Office that an invention composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. (*KSR Int'l v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007)). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” (*Id.*).

While Applicants appreciate that Nakahata may disclose various absorbent article components such as a topsheet and an elastic waist feature, these components are not necessarily extensibility controlling means. Even assuming, for the sake of argument, that the combination of Nakahata and Malowaniec does contemplate the need for an extensibility controlling means, there is still no disclosure that would prompt one of ordinary skill in the art to select one particular component over another, or even to use a pre-existing component rather than simply adding a new component for limiting stretch.

As pointed out above, neither Nakahata nor Malowaniec expressly disclose the desirability of using an elastic waist band as an extensibility controlling means. Nevertheless, even if it were somehow shown that the skilled artisan would be prompted to select an elastic waist band as the extensibility controlling means, the skilled artisan must then select the amount of extension and force recited in claim 1. Applicants appreciate the Office Action's position that the elastic waist band of Nakahata may inhibit the chassis layer from extending beyond 20% at a tension force of 125 grams/25mm;

however, Applicants must point out that it may be just as likely that the elastic waist band itself is much more stretchable than the chassis layer, and therefore provides no inhibition to inhibit the chassis layer from extending beyond 20% at 125 g/25 mm.

In order for the Office Action to make a *prima facie* case of obviousness, the Office must show, without the use of improper hindsight, that one of ordinary skill in the art would be prompted to first select, from any number of possible extensibility controlling means, the elastic waist feature of Nakahata. Then, the skilled artisan must configure the elastic waist feature to exert a tension force of greater than or equal to 125 grams/25mm when the chassis layer extends beyond 20%. All without any disclosure in either Nakahata or Malowanec of such an embodiment. Applicants respectfully submit that there is no evidence to reasonably support this position.

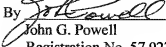
In view of the foregoing, it is Applicants' position that the Office Action has not made a *prima facie* case of obviousness. Accordingly, Applicants respectfully request that the rejection of claims 1, 2, 4, 5, and 7-18 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Conclusion

This response represents an earnest effort to place the present application in proper form and to distinguish the invention as claimed from the applied reference(s). In view of the foregoing, entry of the amendment(s) presented herein, reconsideration of this application, and allowance of the pending claim(s) are respectfully requested.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By 
John G. Powell
Registration No. 57,927
(513) 983-0523

Date: September 8, 2009
Customer No. 27752